

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket No. 14406US03

In the Application of)
Ronald L. Mahany)
Serial No.: 10/657,595)
Filed: September 8, 2003)
For: COMMUNICATION NETWORK)
HAVING A PLURALITY OF)
BRIDGING NODES WHICH)
TRANSMIT A BEACON TO)
TERMINAL NODES IN POWER)
SAVING STATE THAT IT HAS)
MESSAGES AWAITING DELIVERY)
Examiner: PEYTON, TAMMARA R)
Group Art Unit: 2182)
Confirmation No.: 5619)
Customer No.: 23446)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is
being sent via EFS-Web to the United
States Patent and Trademark Office on
February 18, 2009.

/Philip Henry Sheridan/
Philip Henry Sheridan
Reg. No. 59,918

REQUEST FOR RECONSIDERATION OF PETITION TO EXPUNGE PAPERS UNDER
37 C.F.R. § 1.59(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On November 7, 2007, Applicants submitted their Petition To Expunge Papers Under 37 C.F.R. § 1.59(b), which sought to expunge allegedly “Confidential” information from the record. On January 4, 2008, the Office dismissed Applicants’ petition as premature because the present application had not been allowed or abandoned. The Office noted, however, that “[o]nce prosecution on the merits is closed, applicant may re-submit a petition to expunge the information.” Accordingly, because claims 34 and 42-92 have since been allowed (a Notice of Allowance was mailed on February 17, 2009), Applicants hereby re-submit their prior petition to expunge.

On June 3, 2006, the Applicants submitted a Litigation Statement Pursuant to MPEP § 2001.06(c) and Information Disclosure Statement (the “June 3 IDS”), which included copies of

four hundred and sixty-nine (469) printed references that were either cited, produced or relied upon by Qualcomm, Inc. (“Qualcomm”), during the following cases:

- In the Matter of Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, U.S. International Trade Commission Case. No. 377-TA-543 (the “543 Investigation”); and
- Broadcom Corp. v. Qualcomm, Inc., Civil Action No. 05-468 in the Central District of California (the “468 Litigation”)

It has come to our attention that the following six (6) printed references that were submitted to the USPTO in the June 3 IDS were designated by Qualcomm as “Confidential Information” under the Protective Order entered in the appropriate case, and thus, should not have been submitted to the USPTO:

C27	“CDMA Digital CAI Standard, Cellular System Dual-Mode Mobile Station-Base Station Compatability Standard, Draft Rev. 0”, 07/31/1990, Bates Nos. QBB138614-832
C28	“CDMA Digital CAI Standard, Cellular System Dual-Mode Mobile Station-Base Station Compatability Standard, Draft Rev. 1”, 10/01/1990, Bates Nos. QBB138833-9249
C29	“CDMA Digital CAI Standard, Cellular System Dual-Mode Mobile Station-Base Station Compatability Standard, Draft Rev. 1.1”, 07/15/1991, Bates Nos. QBB139250-858
C119	“Proposed EAI,TIA Standard, Cellular System CDMA-Analog Dual-Mode Mobile Station - Base Station Compatibility Standard, Rev. 1.12”, 03/16/1992
C120	“Proposed EAI,TIA Standard, Cellular System CDMA-Analog Dual-Mode Mobile Station - Base Station Compatibility Standard, Rev. 1.13”, 03/23/1992
C431	“Proposed EAI,TIA Standard, Cellular System CDMA-Analog Dual-Mode Mobile Station - Base Station Compatibility Standard, Rev. 1.14”, 04/21/1992

Pursuant to 37 C.F.R. § 1.59(b), the Applicants hereby request that these six references, and all copies (whether paper or electronic) be expunged from the record and either destroyed or returned to the Applicants.

MPEP § 724.05 states the following:

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(g) is included.

(MPEP § 724.05, paragraph II).

In support of this request, the Applicants note that:

- This request is being made prior to the issuance of any patent on the application in issue;
- The above-mentioned references submitted in the June 3 IDS were inadvertently submitted and, according to Qualcomm, the failure to obtain their return may cause irreparable harm to Qualcomm (*See Exhibit A*);
- According to Qualcomm's counsel, the above-mentioned references have not been made public (*Id.*); and
- There is a commitment on the part of the petitioner's counsel to retain such information for the period of any patent with regard to which such information is submitted.

With regards to materiality of the references, Qualcomm's expert in the 543 Investigation conceded that the above-mentioned references are earlier revisions of the publicly available published version that was submitted to the USPTO as:

C121	"Proposed EIA/TIA Interim Standard, Wideband Spread Spectrum Digital Cellular System Dual-Mode Mobile Station – Base Station Compatibility Standard," EIA/TIA/IS-95, 04/21/1992
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As an example, on pages 9-10 of the Second Supplemental Expert Report of Dr. John Proakis (i.e., reference C581), Qualcomm's Expert concedes that reference C27 (i.e., referred to as "Rev. 0") is

cumulative to reference C121 (i.e., referred to as the “Blue Book”). For example, Dr. John Proakis states the following:

The same procedures are also described in the version of the standard which was publicly disclosed in April 1992. I understand that this version of the specification was colloquially referred to as the “Blue Book” because its cover was blue. The teachings of the Blue Book remain the same as Rev. 0, but the description of those teaching have benefited greatly from over two years of editing and are more clearly articulated.

(Second Supplemental Expert Report of Dr. John Proakis, Reference C581, Pages 9-10). The Director, however, should confirm that the references to be expunged are not material information under 37 CFR 1.56 at least because they are cumulative to information already of record in the application.

For the convenience of the USPTO, it is noted that similar Petitions to Expunge Papers under 37 CFR § 1.59(b) have been submitted to and granted by the USPTO in the following applications:

- 10/631,071, now U.S. Patent No. 7,457,646 (Attorney Docket No. 14406US02),
- 11/009,338, now U.S. Patent No. 7,415,548 (Attorney Docket No. 14406US04),
- 10/965,991, now U.S. Patent No. 7,483,397 (Attorney Docket No. 14771US02), and
- 10/787,443 (Attorney Docket No. 14425US02).

Finally, there is no petition fee due because the fee was previously submitted in connection with the original petition. (*See* the Decision on Petition mailed by the PTO on January 4, 2008, stating that “[n]o further fee is required for such a second submission of a petition under 37 CFR § 1.59 to expunge information.”) In the event that there is a fee due, please charge such fees to Deposit Account No. 13-0017 in the name of McAndrews, Held & Malloy, Ltd.

Thus, for each of the above-mentioned reasons, Applicants request that the six references referred to above, and all copies (whether paper or electronic) be expunged from the record and either destroyed or returned to the Applicants, pursuant to 37 C.F.R. § 1.59(b).

Respectfully submitted,

Date: February 18, 2009

/Philip Henry Sheridan/
Philip Henry Sheridan
Reg. No. 59,918

McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(T) 312 775 8000
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EXHIBIT A

October 31, 2007

VIA EMAIL

Ronald H. Spuhler, Esq.
Philip H. Sheridan, Esq.
McAndrews, Held & Malloy LTD
500 West Madison Street, 34th Floor
Chicago, IL 60661

**Re: *In the Matter of Certain Baseband Processor Chips and
Chipsets, Transmitter and Receiver (Radio Chips), Power
Control Chips, and Products Containing Same, Including
Cellular Telephone Handsets, Inv. No. 337-TA-543***

Counsel:

I write in response to your telephone conversation with Sonia Murphy, and subsequent email correspondence, in which you notified us that your firm provided six confidential QUALCOMM documents to the U.S. Patent and Trademark Office ("PTO") in connection with certain unspecified patent applications your firm is prosecuting on behalf of Broadcom Corporation ("Broadcom").¹ QUALCOMM objects to your firm's disclosure of QUALCOMM documents that are designated as "containing confidential business information" to the PTO, and regards such disclosure as a breach of the ITC's Protective Order.

The Protective Order issued in the above-referenced investigation by Administrative Law Judge Bullock on June 21, 2005, provides that documents designated by their supplier as containing confidential business information "shall not be disclosed" to persons not bound by the terms of the Protective Order without "written permission" of the supplier. *See* Protective Order, Order No. 1, ¶¶ 3 and 4. The documents identified in your email as having been provided by your firm to the PTO were each designated by QUALCOMM as containing QUALCOMM confidential information. Each bears on its face a clear indication, pursuant to paragraph 2(a) of

¹ Specifically, McAndrews attorneys provided the following QUALCOMM confidential documents to the PTO:

1. CDMA Digital CAI Standard Draft Revision 0, 07-31-1990 (starting at QBB138614)
2. CDMA Digital CAI Standard Draft Revision 1.0, 10-01-1990 (starting at QBB138833)
3. CDMA Digital CAI Standard Draft Revision 1.1, 07-15-1991 (starting at QBB139250)
4. Proposed EAI-TIA Standard Revision 1.12, 03-16-1992 (starting at QBB140457)
5. Proposed EAI-TIA Standard Revision 1.13, 03-23-1992 (starting at QBB141243)
6. Proposed EAI-TIA Standard, 04-21-1992 (starting at QBB141939)

HOWREY

Ronald H. Spuhler, Esq.

Philip H. Sheridan, Esq.

October 31, 2007

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the Protective Order, of its confidential status. Moreover, each of the documents was listed as confidential on QUALCOMM's final hearing exhibit list, and each was admitted into evidence as confidential at the hearing in the investigation. 3/13/06 Hrg. Tr. 1156:9-10. Thus, each of the documents in issue was consistently treated by QUALCOMM as confidential throughout the investigation and following.

Broadcom's use of these documents in PTO proceedings, without QUALCOMM's express written permission, is an apparent breach of at least paragraphs 3 and 4 of the Protective Order. QUALCOMM does not consent to Broadcom's disclosure of these documents to the PTO. To the extent McAndrews believed the documents did not contain confidential information, as defined by the Protective Order, it should have sought formal declassification of the documents. McAndrews did not have the authority to determine unilaterally that the documents are not entitled to confidential treatment, and to disclose them to others. Inasmuch as the documents remain confidential and were provided to the PTO by McAndrews in violation of the Protective Order, QUALCOMM insists that the documents be immediately retrieved from the PTO. See Protective Order, ¶ 12 (requiring party in breach of the Protective Order to "make every effort to prevent further disclosure" of confidential materials). Further, QUALCOMM insists that Broadcom discharge its obligation under ¶12 of the Protective Order to notify the Administrative Law Judge and/or the Commission of this breach, and immediately take all necessary steps to limit prejudice to QUALCOMM resulting from the unauthorized disclosure of QUALCOMM's confidential information.

QUALCOMM has expressed to Broadcom its concerns about simultaneous involvement of attorneys from McAndrews in (1) patent prosecution work on behalf of Broadcom and (2) litigation between Broadcom and QUALCOMM that involves access to confidential information supplied by QUALCOMM pursuant to the ITC and district court protective orders. The basis for QUALCOMM's concern is precisely what has now happened – the use of QUALCOMM's confidential information in connection with Broadcom's patent prosecution activities. The potential prejudice to QUALCOMM from such conduct is obvious. Indeed, McAndrews's actions in this instance raises concerns about what other QUALCOMM confidential information has been used, by provision to the PTO or otherwise, in connection with Broadcom's patent prosecution activities.

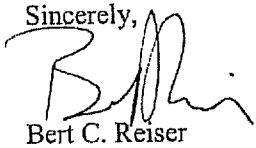
To that end, QUALCOMM requests that Broadcom provide: (1) a list of all McAndrews attorneys involved in Broadcom patent prosecution who have received or reviewed in any context QUALCOMM confidential information submitted under the terms of any protective order; (2) a list of all such materials that they have received or reviewed; and (3) a list of *all* materials that Broadcom has provided to the PTO that were produced to Broadcom under protective order restrictions in litigation between Broadcom and QUALCOMM. QUALCOMM reserves all rights to investigate and address by any available means McAndrews's breach of the Protective Order and the resultant prejudice to QUALCOMM.

HOWREY

Ronald H. Spuhler, Esq.
Philip H. Sheridan, Esq.
October 31, 2007
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Thank you for your prompt attention to this matter.

Sincerely,



Bert C. Reiser



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November 13, 2007

VIA EMAIL

Bert C. Reiser
Howrey, LLP
1299 Pennsylvania Avenue, N.W.
Washington, DC 20004-2402

Re: Submission of documents from ITC Investigation No. 337-TA-543

Bert:

I write in response to your October 31, 2007 letter.

McAndrews takes the Protective Order, and any suggestion that there has been any actions taken in contravention thereof, very seriously. This is why on September 27, 2007, shortly after realizing that there may be an issue, we contacted Sonia Murphy of your firm to determine whether Qualcomm maintained that the six documents in question constituted "Confidential Business Information." As you know, the parties have met and conferred many times in the last year regarding the Confidential Business Information designation Qualcomm had given to certain documents; in many cases, following Broadcom's inquiry, Qualcomm determined that the documents did not in fact merit such designation and permitted Broadcom to submit such documents to the PTO (notwithstanding the fact that the documents still bore a "Confidential Business Information" label on their face). In addition, it is my understanding that each of these six documents is the draft technical specification, the final version of which Qualcomm argued – in both this Investigation and Case No. 467 in Santa Ana – was eventually made public.

Qualcomm took nearly a month to respond to our inquiry. We understand from your letter that Qualcomm maintains that each of these documents has never been publicly disclosed and is properly labeled CBI. Immediately upon receiving Qualcomm's response, we filed petitions to expunge these documents from the PTO's records. In addition, MHM simply electronically submitted the relevant documents that it received in electronic form, without analysis. Thus, we do not believe that anyone from MHM who



Mr. Bert Reiser
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has not subscribed to the Protective Order has ever seen or reviewed these six documents, let alone "use" the documents, as your letter incorrectly suggests. Similarly, while these documents were submitted to the Patent and Trademark Office as part of a compilation of cited prior art references, the documents were not available on the PTO website and were submitted as part of a large volume of documents (nearly 1,600 documents, constituting tens of thousands of pages) disclosed in the IDS; to our knowledge, no third party has reviewed these documents.

Nonetheless, in light of Qualcomm's position that these six documents are CBI, Broadcom intends to send a letter to Judge Bullock informing him of this situation.

Finally, Qualcomm's nearly month long delay in responding to this inquiry belies your suggestion that Qualcomm has suffered any prejudice.

Please feel free to call with any questions.

Sincerely,

/rhs/

Ronald H. Spuhler

cc: Phillip Sheridan, Esq.
Mark Selwyn, Esq.